

UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

In re Examination of \_\_\_\_\_

) Decision on request to  
) review the OED Director's  
) regrade decision  
) of March 28, 1991

I

petitions for review of the decision on her request for regrade of her answer to Question 2 in the afternoon section of the October 1990 Examination for Registration. You allege that the decision by the Director of Enrollment & Discipline (Director) on regrade of Question 2 was incorrect. You thus ask for further regrade, and an award of sufficient additional points for your answer to provide you with a passing grade for the afternoon section. As set forth below, the Director's decision is affirmed, and the requests for regrade and additional points are denied.

II

Question 2 involved a hypothetical patent application for an invention of Kay Tuhne for a novel sintered ceramic composition. As patent counsel for Ceramic America Corporation (CAC) who was the assignee of all right, title, and interest in the patent application, you were required to prepare an information disclosure statement for this patent application. The instructions advised you specifically that (underlining added):

You have determined that all information set forth above is material to the examination of Kay's application . . . .

Your Information Disclosure Statement must comply with all requirements of PTO rule provisions and include information which "should" be included in the Information Disclosure Statement under the rules.

The Patent and Trademark Office's (PTO's) rule on duty of disclosure defines information as material "where there is a substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent." 37 CFR § 1.56(a).

37 CFR § 1.98(a) sets forth the requirements of information disclosure statements.

Any disclosure statement filed under § 1.97 or § 1.99 shall include: (1) A listing of patents, publications or other information; and (2) A concise explanation of the relevance of each listed item. . . . Each printed publication should be identified by author (if any), title of the publication, pages, date and place of publication.

Question 2 was worth a total of 30 points. Nine points was deducted from your score on this question as follows:

1. Patent No. 9,000,000 - failure to list properties (-1 point).
2. Ceramic Journal - failure to list:
  - a. place of publication (-1 point);
  - b. pertinent pages (-1 point);
  - c. weightings (-1 point); and
  - d. utility (-1 point).
3. Internal CAC memorandum - failure to list:
  - a. country of sale (-2 points);
  - b. weighting (-1 point); and

c. properties (-1 point).

### III

A. For Items 1, 2c, 2d, 3b, and 3c, one point each was deducted for failing to list the weightings, the properties, and the utility disclosed in the references. In his decision on regrade, the Director stated:

The omitted information is important to the examination of the application as to whether or not the ceramic in the references is suggestive of the claimed invention and if there is a motivation to use it for the same intended purpose of the invention.

In the instructions, you were advised that this information was material to the examination of Kay's application. However, your answer merely stated that:

For Item 1 - the patent "discloses a method of making silicon carbide having at least 95% of the silicon carbide in the alpha phase;"

For Item 2c and 2d - "The Ceramic Journal discloses a sintered ceramic comprising silicon carbide, carbon, and boron;" and

For Items 3b and 3c - the CAC memo describes "a sintered ceramic comprising silicon carbide, carbon, and boron."

Your argument that "Rule 1.98 does not obligate one to restate what is plainly evident from the face of a document" is plainly wrong. First, your statements listed above fail to include a concise statement of the relevance of each item as

required by Rule 1.98. Merely stating that these items are ceramics or consist of the same general elements hardly establishes their relevance. Second, dumping references in bulk on examiners and leaving it up to them to divine their relevance is unacceptable. Third, your fear of file wrapper estoppel does not relieve practitioners from their duty to submit admittedly material information to examiners. Fourth, your argument concerning file wrapper estoppel also overlooks the fact that you have already identified these references as material when you submitted your information disclosure statement. I agree that a practitioner would be estopped from maintaining that these references are not relevant to the examination of the Kay patent application. However, simply repeating what the reference expressly states hardly creates any further estoppel. You were not required to speculate or expand on what the references contained. You were only required to disclose information material to the examination of the Kay application to the examiner.

Specifically, as patent counsel, you knew that it was material to the examination of the Kay application that the ceramic had "excellent resistor properties and would be particularly useful in high technology electrical circuits." I see no error in deducting one point for your failure to include in your information disclosure statement that Patent No. 9,000,000 also claimed to have excellent resistor properties and would be useful in high technology electrical

circuits. Motivation to use is especially relevant to whether references suggest the invention. See In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Also, it was proper to deduct one point each for failing to include the weightings and utility in the statement regarding the Ceramic Journal article (Items 2c and 2d). Again, you were advised that this information was material. However, your statement regarding the Ceramic Journal article simply reported that the article disclosed "a sintered ceramic comprising silicon carbide, carbon, and boron." Rule 1.98 requires a concise explanation of the relevance of each item. Your explanation fails to establish the relevance of the information. It merely states that it is a sintered ceramic with the same elements. Since you failed to include material information regarding the weightings and utility of the ceramic in your statement, deducting two points was justified.

Your disclosure for Items 3b and 3c was likewise unenlightening, and the Director properly deducted one point each for failing to identify the properties and weighting.

B. You also lost one point each for items 2a and 2b for failing to disclose the place of publication and the pertinent pages of the Ceramic Journal article. Rule 1.98(a) states: "[e]ach printed publication should be identified by author (if any), title of the publication, pages, date and place of publication." The examination instructions require that your information disclosure statement must include information which


"should" be included in these statements. You failed to include this information in your statement; therefore, two points were properly deducted. Your assertion that the pertinent page number might be found on another form does not meet the requirement of Rule 1.98 that the statement contain the information.

C. Finally in Item 3a, two points were deducted for failing to include the country of sale of the CAC internal memorandum. This information was known to you and material; yet it was not included in the sales slip or the CAC memorandum. The country of origin is necessary to determine if the sale would be prior art. I find no error in deducting two points for failing to supply this information.

#### IV

The petition is granted to the extent that the Director's decision was reviewed. However, the request for regrade and an award of additional points is denied.

Date: 8/7/91

  
EDWARD R. KAZENSKE  
Executive Assistant to the  
Commissioner of Patents  
and Trademarks and  
Director of  
Interdisciplinary Programs

cc: